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RCE Amendment and/or Response
Reply to final Office action of 19 February 2008

Reply under 37 CFR 1.114
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REMARKS / DISCUSSION OF ISSUES

Claims 14-33 are pending in the application; claims 1-13 are canceled and claims 14-33 are newly added. In the interest of advancing prosecution in this case, the claims are rewritten in a form that will hopefully serve to avoid the prior issues related to the particular terms and phrases used in the claims. The intended scope of the claims is substantially unchanged from the originally filed claims.

The Office action had rejected claims 1-13 under 35 U.S.C. 102(e) over Balnaves et al. (USP 6,954,894, hereinafter Balnaves). The following comments are provided with regard to the rewritten claims in view of Balnaves.

MPEP 2131 states:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Balnaves fails to teach marking a part of a representation of a recorded data sequence extending from a first user-selected position to the end of the representation, and fails to teach unmarking a part of the representation extending from the second user-selected position to the end of the representation, as specifically claimed in claim 14, upon which claims 15-22 depend.

Similarly, Balnaves fails to teach a processor that marks a first part of a representation of a recorded data sequence extending from a user-selected first position in an unmarked part of the representation to the end of the representation, and fails to teach a processor that unmarks a second part of the representation extending from a second user-selected position in the first part of the representation to the end of the representation, as specifically claimed in claim 23, upon which claims 24-33 depend.

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The Office action refers to Balnaves' FIG. 6A for teaching the marking of a representation of a recorded data sequence. The following features clearly distinguish Balnaves' marking of the representation from the applicants' claimed invention.

Of particular note, Balnaves refers to a single user-selected position 205 to create a set of marked (dark areas, 610-611) and unmarked (light areas) parts of the representation, whereas the applicants' claim the use of multiple user-selected positions for independently marking and unmarking parts of the representation.

Balnaves uses the single user position 205 to automatically determine the duration 606-607to the left and right of the position 205 to mark. The applicants claim the marking of the entire part of the representation from the user-selected first position to the end of the representation, and the unmarking of the entire part of the representation from the user-selected second position. The applicants respectfully maintain that the Balnaves' automatic determination of a beginning and end of a marked region based on a single user-selected position 205 cannot be said to be "identical" to the independent selection of two user-selected positions, nor can Balnaves be said to have presented such independent selections in "as complete detail" as contained in the applicants' claims.

In addition to not teaching the claimed marking and unmarking, the applicants respectfully maintain that the marking of the part of the representation from Balnaves' position 205 to the end of the representation would render Balnaves' invention unsuitable for its intended function, because Balnaves relies upon the system to find both the beginning and end of the segment of the presentation that includes the single position 205. Marking the presentation from the position 205 to the end would, in almost all cases, be contrary to the intent of Balnaves' teachings, because it would identify more segments than the particular segment that the user likes or dislikes. In like manner, unmarking the presentation from the position 205 to the end would, in most cases, truncate the particular segment that the user likes or dislikes, making the determination of the features within the segment prone to error when it ignores material portions of the segment.

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Because Balnaves fails to teach each of the aspects of the applicants' claimed invention, and because the features taught in this application are contrary to Balnaves' teachings, the applicants respectfully maintain that claims 14-33 are patentably distinct from Balnaves' teachings.

In view of the foregoing, the applicants respectfully request that the Examiner allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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